IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	
Upasani *et al.*	Art Unit: 1616
Appl. No. 09/321,882	Examiner: Badio, B.
Filed: May 28, 1999	Atty. Docket: 1483.0130002/JMC/BEC
For: **Neuroactive Steroids of the Androstane and Pregnane Series**	

Reply To Restriction Requirement

11-16-99

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated September 9, 1999, requesting an election of one invention to prosecute in the above-referenced patent application (Paper No. 3, paragraph 1), Applicants hereby provisionally elect to prosecute the invention of Group II, represented by claims 1, 2, 25-28 and 46-57.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse. *In re Weber* 198 USPQ 332 (CCPA 1978) and its companion case, *In re Haas*, 198 USPQ 334 (CCPA 1978), held that restriction practice is *not* applicable to a single claim. These cases made it clear that 35 U.S.C. § 121 does not grant to the PTO the authority to refuse to examine a single claimed invention. Section 121 only applies to *plural* claimed inventions in *different* claims, wherein the different claims vary not just in scope, but in the invention to which each is directed. Moreover, these cases made it clear, that a refusal to examine a single claim based upon a 35 U.S.C. § 121, i.e., withholding a claim from consideration because it allegedly comprises independent or distinct inventions, is an appealable, as opposed to a petitionable matter. Finally, Applicants submit

that search and examination of at least Groups I and II together would not present a serious burden to the Examiner or the PTO, despite the different classifications for these groups.

The restriction requirement is also traversed to the extent that a search of one or more methods of use along with the compound claims would not result in an undue burden being placed on the U.S. Patent and Trademark Office. Applicants reserve the right to file one or more divisional applications directed to the non-elected claims.

The Examiner has also required election of a single disclosed compound species with respect to claims 1, 2, 25-29, 35-43 and 46-57. (Office Action, Paper No. 3, paragraph 4). Applicants hereby provisionally elect the species:

3α-hydroxy-3β-methyl-21-(quinolin-6-yloxy)-5α-pregnan-20-one.

This compound is listed at page 26, lines 27-28, and in claim 27 of the application as filed.

Currently, claims 1-2, 25-27, 46, 51, 54-55 and 57 read upon the elected compound.

The election of species requirement is provisionally traversed to the extent that examination may not be conducted pursuant to the guidelines set forth at MPEP § 803.02. Applicants reserve their right to traverse if the procedure outlined in this section of the MPEP is disregarded.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby

petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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Date: Nov. 9, 1999

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